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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,962	08/25/2003	Wei Zhao	9400-44	3021

39072 7590 04/04/2007  
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EXAMINER
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CHO, UN C

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/646,962

Applicant(s)

ZHAO ET AL.

Examiner

Un C. Cho

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 9, 12, 17 and 20 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, line 4 recites the limitation “wherein the user request comprises non-communication amenities” and line 8 recites “the non-communication amenities”.

Claim 9, lines 1 – 2 recite “wherein the non-communication amenities”.

Claim 12, line 2 recites “non-communication amenities”.

Claim 17, line 4 recites the limitation “the user request further comprising non-communication amenities” and line 8 recites “provides access to the requested non-communication amenities”.

Claim 20, lines 6 – 7 recite the limitation “the user request further comprising non-communication amenities” and line 11 recites “provides access to the requested non-communication amenities”.

After carefully reviewing the specification, the examiner would like to raise the question with regards to the limitation “non-communication amenities”. The presence of

Art Unit: 2617

the above-mentioned limitation cannot be found anywhere in the specification, however, the closest paragraphs that might be related to the term "amenities" are found in Paragraph 0007, 0032 and 0039.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 9, 12, 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, 12, 17 and 20 recite the limitation "non-communication amenities". However, it is unclear what the phrase "non-communication amenities" is and the term "non-communication" does not positively identify the claim.

Claim 9 line 2 recites the term "and/or" which does not positively identify the claim limitation.

For purposes of the prior art rejection the examiner interprets the limitation "non-communication amenities" as being a service that is provided to the mobile user as recited in applicant's specification in paragraphs 0007, 0032 and 0039.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 7, 9 – 16 and 20 – 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 20 is directed to a computer program product. The examiner asserts that the claimed subject matter does not fall within the statutory classes listed in the interim guideline of 35 USC 101 (see pages 52 – 57 of the interim guideline). Moreover, while the claimed invention may be labeled as a computer program product, it is in fact non-functional descriptive material. Therefore, dependent claims 21 – 22 are also rejected because of the dependency on claim 20 containing the same deficiency.

Claim 1, is the method of claim 20 that is in fact non-functional descriptive material. Therefore, dependent claims 2 – 7, 9 – 16 are also rejected because of the dependency on claim 1 containing the same deficiency.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 4 and 11 – 22 are rejected under 35 U.S.C. 102(e) as being anticipated by H. Grey (US 2004/0203873 A1 hereinafter Grey).

Regarding claim 1, Grey discloses receiving a mobile user request for a location of a wireless network access point via a user terminal, wherein the user request comprises a service (Grey: Page 4, Paragraph 0035, lines 1 – 7 whereas the user requests position and/or direction to one or more nearby WLAN access points so that the user can have access to the Internet); identifying a geographic location of the mobile user responsive to receiving the user request (Grey: Page 4, Paragraph 0036, lines 1 – 8); and identifying a wireless network access point convenient to the user that provides access to the service (Grey: Page 4, Paragraph 0035, lines 1 – 7 and Paragraph 0037, lines 1 – 22).

Regarding claim 2, Grey discloses communicating the identified wireless network access point to the user (Grey: Page 4, Paragraph 0038, line 1 through Paragraph 0039, line 7).

Regarding claim 3, Grey discloses locating a wireless communication signal from the user terminal (Grey: Page 4, Paragraph 0036, lines 1 – 8).

Regarding claim 4, Grey discloses comparing the geographic location of the user to known locations of a plurality of access points (Grey: Page 4, Paragraph 0037, lines 1 – 22).

Regarding claim 5, Grey discloses calculating a travel time between the user location and each of the plurality of wireless network access points (finding the nearest WLAN access point to the user, whereas in order to find the nearest the system must inherently calculate a travel time between the user location and each of the plurality of wireless network access points); and selecting one of the

plurality of wireless network access points having the shortest travel time (Grey: Page 4, Paragraph 0037 line 1 through Paragraph 0038, line 9).

Regarding claim 11, Grey discloses communicating directions from the user location to the selected wireless network access point (Grey: Page 4, Paragraph 0038, lines 1 – 9).

Regarding claim 12, Grey discloses communicating information concerning services to the user terminal (nearby WLAN access points position and/or direction is provided to the user; Grey: Page 4, Paragraph 0035, lines 1 – 7).

Regarding claim 13, Grey discloses wherein the wireless network is a broadband wireless network (Grey: Page 3, Paragraph 0033, lines 1 – 24).

Regarding claim 14, Grey discloses wherein the broadband wireless network is a WiFi network (802.11 is the standard for WiFi network; Grey: Page 3, Paragraph 0033, lines 1 – 24).

Regarding claim 15, Grey discloses wherein the user terminal is a mobile communications device (Grey: Page 2, Paragraph 0021, line 1 through Paragraph 0022, line 17).

Regarding claim 16, Grey discloses wherein the user terminal is a computer processor terminal (Grey: Fig. 6, element 18 represents the mobile appliance having a processor (Fig. 6, element 180)).

Regarding claims 17 and 20, the claims are interpreted and rejected for the same reason as set forth in claim 1.

Regarding claims 18 and 21, the claims are interpreted and rejected for the same reason as set forth in claim 4.

Regarding claims 19 and 22, the claims are interpreted and rejected for the same reason as set forth in claim 5.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grey in view of Barnes Jr. (US 2005/0136949 A1 hereinafter Barnes).

Regarding claims 6 and 7, Grey as applied above does not specifically disclose wherein calculating a travel time is based on distance and road conditions and wherein the road conditions comprise real-time traffic conditions. In an analogous art, Barnes remedies the deficiencies of Grey by disclosing that once a PI is identified (from a user request), the information is supplied to the user as directions, the closest PI, the distance and any traffic delays (Barnes: Page 15, Paragraph 0151, lines 1 – 16; Paragraph 0154, lines 1 – 17; Page 16, Paragraph 0159, lines 1 – 15; Paragraph 0156, line 1 through Paragraph 0157, line 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Barnes to the



system of Grey in order to allow the user to judge how long it will take to arrive at the location so that the user may take actions accordingly (Barnes: Page 17, Paragraph 0169, lines 1 – 11).

Regarding claim 10, Grey discloses wherein the user request includes a particular service provider associated with the wireless network (a request for positioning and/or directing the user to one or more nearby WLAN access points; Grey: Page 4, Paragraph 0035, lines 1 – 7).

However, Grey as applied above does not specifically disclose identifying a wireless network access point further comprises identifying a wireless network access point provided by the particular service provider. In an analogous art, Barnes remedies the deficiencies of Grey by disclosing a mobile terminal selecting a communication system based on availability and cost, among other parameters (Barnes: Page 6, Paragraph 0064, line 1 through Page 7, Paragraph 0069, line 22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Barnes to the system of Grey in order to effectively select a service provider based on the user needs (Barnes: Page 6, Paragraph 0065, line 1 through Paragraph 0066, line 21).

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grey in view of Joyce et al. (US 6,798,358 B2).

Regarding claim 9, Grey as applied above does not specifically disclose wherein the services include a type of facility and/or service available in the vicinity of the wireless network access point. In an analogous art, Joyce remedies the deficiencies of Grey by disclosing services which might include a type of facility and/or service such as advertisements, traffic advisories, weather advisories, maps, directions, historical information, etc. in the vicinity of the wireless network access point (Joyce: Col. 3, line 52 through Col. 4, line 17 and Col. 8, lines 31 – 46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the technique of Joyce to the system of Grey in order to provide an effective and efficient method for delivering content to a mobile terminal based on location.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1 – 7 and 9 – 22 have been considered but are moot in view of the new ground(s) of rejection.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C. Cho whose telephone number is (571) 272-7919. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Un C Cho  
Examiner  
Art Unit 2617

3/28/07 *uc*

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER